

**REMARKS**

Reconsideration and withdrawal of the rejections to this application are respectfully requested in view of the following remarks which place the application in condition for allowance.

This application relates to, *inter alia*, silencers for muffling the exhaust noise of internal combustion engines. One of the unique features of the instantly claimed invention is modularity. More specifically, the present invention provides for an exhaust silencer with a gas-conducting, perforated pipe selected from a plurality of gas-conducting, perforated pipes with different damping characteristics.

Claims 8-12 are pending. Claims 8-12 were amended, without prejudice, to advance prosecution. The amendment and the remarks made herein are not made for reasons related to patentability and, thus, do not prevent the application of the doctrine of equivalents. Support for the amended recitations in the claims is found throughout the specification.

No new matter has been added.

Claim 12 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claim 12 was also rejected under 35 U.S.C. §101 for allegedly reciting a use without setting forth the steps involved. The rejections will be collectively addressed and are respectfully traversed.

The amendment to claim 12 renders the rejections moot. Consequently, reconsideration and withdrawal of the Section 112, second paragraph, and Section 101 rejections are respectfully requested.

Claims 8-12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,332,873 to Kullander et al. ("Kullander") in view of U.S. Patent No. 3,993,160 to Rauch ("Rauch."). The rejection is traversed. Neither Kullander nor Rauch, either alone or in combination, teach, suggest, or motivate a skilled artisan to practice, the instantly claimed invention.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, the requisite teaching, suggestion or motivation is lacking in the Kullander and Rauch patents, thereby rendering the obviousness rejection defective. Kullander relates to a motor vehicle muffler. The muffler has an exhaust conduit—surrounded by a filler material—extending inside a housing. The housing has two half shells, the bottoms of which are interconnected via plate 13. Plate 13 has a central slot or notch 16 and notches 17 and 18 at either end, the notches being shaped such that, when the muffler is assembled, plate 13 does not touch any portion of pipe 4. *See* column 2, line 63, to column 3, line 2. In contrast to the present

invention, however, plate 13 of Kullander, with its end flanges 14 and 15, do not define chambers within housing 1 that are insulated gas-tight from each other. Further in contrast to the Applicants' invention, as the Kullander muffler has only a single chamber defined by two half shells, the Kullander muffler is not capable of tuning an interference frequency band from the noise spectrum.

Rauch does not remedy the inherent deficiencies in Kullander. Rauch relates to an exhaust silencer. Contrary to the instant invention, however, the Rauch silencer has a closed case and at least two perforated tubes extending substantially parallel to each other and in a straight line. Rauch does not teach, suggest or motivate a skilled artisan to practice the instant exhaust silencer having a gas-conducting pipe having openings of a defined cross-section and defined wall height, arranged in a silencer housing in such a manner that it runs through an axial series of silencer housing chambers insulated gastight from each other, into which the openings of the gas-conducting pipe communicatively open, whereby the volumes of all chambers of the silencer housing in connection with the defined openings specifications of all openings of the openings of the pipe communicatively aligned with the respective silencer housing chamber are tunable to an interference frequency band from the noise spectrum of the exhaust gases to be dampened respectively, and the gas-conducting pipe can be led through the silencer housing chambers in such a manner that the latter run through each of the silencer housing chambers at least twice, with minimal dissipation losses, wherein the gas-conducting pipe is constructed as a modular part for a two-part silencer housing, and the modular part of a modular series of modular parts is configured with different openings characteristics, tuned to the same respective silencer housing chamber volumes.

Also, the combination of Kullander and Rauch do not teach or suggest modularity. More specifically, and in contrast to Applicants' invention, neither reference provides for an exhaust silencer with a gas-conducting, perforated pipe selected from a plurality of gas-conducting, perforated pipes with different damping characteristics.

Further, the Examiner is respectfully reminded that "obvious to try" is not the standard by which an obviousness rejection should be based. And as "obvious to try" would be the only standard that would give the instant Section 103 rejections credence, the rejections must fail as a matter of law.


Accordingly, reconsideration and withdrawal of the Section 103 rejection based on the preceding documents are respectfully requested.

Pursuant to the provisions of 37 C.F.R. §§ 1.17(a) and 1.136(a), Applicants petition the Assistant Commissioner to extend the time period for Applicants to respond to the outstanding Office Action by two (2) months, i.e., up to and including August 27, 2003. A check for \$410.00 is enclosed with this Amendment. Applicants authorize the Assistant Commissioner to charge any additional fee for consideration of this amendment, or credit any overpayment, to Deposit Account No. 50-0320.

In view of the above remarks, it is respectfully submitted that this application is now in condition for allowance. Favorable consideration of the claims is earnestly solicited. If, however, there is still an outstanding issue, the Examiner is urged to contact the undersigned for its prompt attention.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By:   
Mark W. Russell  
Reg. No. 37,514  
Samuel H. Megerditchian  
Reg. No. 45,678